

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/392,619  
Attorney Docket No. Q55694

**REMARKS**

Claims 1-46 are all the claims pending in the application.

Applicant thanks the Examiner for approving the drawings filed on September 9, 1999.

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority based on the priority document filed in U.S. Application No. 09/392,619. Applicant also thanks the Examiner for initialing and returning the Information Disclosure Statements filed on September 20, 2001 and March 5, 2002, and for placing them in the record of the file.

The Examiner rejects claims 1-3, 5-8, 10-19, 22-34 and 37-46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,754,636 to Bayless et al. Claims 1, 5, 10, 23 and 46 are independent claims, and Applicant's arguments traversing the Examiner's § 102(b) rejections will focus on these claims.

With respect to claim 1, the Examiner alleges that Bayless discloses all of the features of Applicant's invention as claimed in claim 1. Applicant respectfully disagrees.

One of the features of Applicant's invention as claimed in claim 1 is "selecting character information on a window screen initiated by said operating system and storing the selected character information ". The Examiner alleges that Bayless discloses this feature at column 16, line 59 through column 17, line 67. Applicant respectfully disagrees.

Bayless discloses a window in which the user can select a directory by selecting a directory icon 208 with a mouse pointer 64 (Bayless, column 17, lines 45-59). These icons, however, are not character information. Figure 14 clearly shows that icons 208 through 210 are

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/392,619  
Attorney Docket No. Q55694

images; they contain no character information. Furthermore, when the icon is selected, no information is stored, the contents of that directory are simply displayed (Bayless, column 17, lines 45-59).

Another of the features of Applicant's invention as claimed in claim 1 is "originating a telephone call to a telephone circuit based on the extracted telephone number and transferring and storing all of the selected character information ". The Examiner alleges that Bayless discloses this feature at column 25, line 30 through column 26, line 20 and column 42, line 25 through column 44, line 25. Applicant respectfully disagrees.

The specification of Bayless at column 25, line 30 through column 26, line 20 does not disclose or suggest this feature. In particular, this portion of the disclosure of Bayless discusses the display of information about calls already in progress (column 25, lines 36-37 and column 26, lines 11-13). Therefore, it does not disclose "originating a telephone call" as required by claim 1.

In addition, the disclosure of Bayless at column 42, line 25 through column 44, line 25 does not disclose "transferring and storing all of the selected character information to and into a telephone directory address storage section". Bayless discloses searching for numbers already stored in a phone directory using a name lookup (column 43, line 36-45). However, selected character information is not transferred or stored into a telephone directory address storage section as claim 1 requires.

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/392,619  
Attorney Docket No. Q55694

Because Bayless does not disclose or suggest at least these features of Applicant's invention as claimed in claim 1, claim 1 is not anticipated by (i.e. is not readable on) Bayless at least for this reason.

Claim 5, 10, 23, and 46 recite methods, apparatuses, and storage media having features analogous to the features of claim 1 of “selecting character information...and storing the selected character information”, “extracting a telephone number from within the selected and stored character information, originating a telephone call to a telephone circuit based on the extracted telephone number”, and “transferring and storing all of the selected character information to and into a telephone directory address storage section” that are discussed above. Therefore, the arguments traversing the rejection of claim 1 also apply to these claims as well.

The Examiner rejects claims 4, 9, 21, 22, 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Bayless in view of U.S. Patent 6,064,725 to Nakanishi. Applicant respectfully traverses this rejection.

Claims 4, 9, 21 and 22, and 35 and 36 are dependent on claims 1, 5, 10, and 23, respectively, and are allowable at least by virtue of their dependency on claims 1, 5, 10, and 23, respectively. Nakanishi does not supply the above-noted deficiencies of Bayless with respect to these independent claims. In particular, Nakanishi does not disclose or suggest “selecting character information on a window screen... extracting a telephone number from within the selected and stored character information... originating a telephone call... based on the extracted telephone number... and transferring and storing all of the selected character information to and

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/392,619  
Attorney Docket No. Q55694

into a telephone directory address storage section”. Nakanishi discloses that when the telephone number to be called is displayed, a CPU originates the call (Nakanishi, column 10, lines 32-35). However, Nakanishi does not disclose the storing of all the selected character information into a telephone directory address storage section. In fact, when the telephone call is being originated to a selected telephone number in Nakanishi, nothing is stored. Nakanishi discloses that call histories are stored based on calls originated by other parties, but Nakanishi discloses that the call-history storing portion is separate from the telephone directory storing portion (Nakanishi, column 6, lines 32-38 and lines 19-22). Nakanishi discloses that information can be stored in the telephone directory storing portion through manual entry of the numbers in the keypad (Nakanishi, column 6, lines 28-31).

Because Nakanishi does not disclose or suggest the features of claim 1 of “originating a telephone call... based on the extracted telephone number... and transferring and storing all of the selected character information to and into a telephone directory address storage section”, Nakanishi does not supply the deficiencies in Bayless at least with respect to these features.

Furthermore, even assuming *arguendo* that the combination of Bayless and Nakanishi did teach or suggest all of the features of Applicant’s invention as claimed in claims 1, 5, 10, and 23, there is no suggestion in either Bayless or Nakanishi that would motivate one of ordinary skill in the art to combine the references.

In particular, these references are not combinable because they teach unrelated art. Bayless relates to software and telephone systems for performing telephone operations using

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/392,619  
Attorney Docket No. Q55694

personal computers (Bayless, column 1, lines 11-14). Bayless relies on a client-server computer network architecture in which the client computer is using a typical window based graphical user interface operating environment (Bayless, column 1, lines 50-62 and column 2, lines 3-6).

By contrast, Nakanishi relates to a call-history display method for use in a portable telephone. Nakanishi relates to a very limited function (call history) and is applicable only to portable telephones, which have very limited processing capability, and which do not have graphical user interfaces (Nakanishi, column 1, lines 7-10; column 4, lines 60-65; and Figure 14). Nakanishi relates to very limited and very specialized telephone devices, unlike Bayless, which relates to sophisticated software running on general-purpose personal computers.

One of ordinary skill in the art would not have been motivated to modify the software of Bayless, which is sophisticated and flexible, with the call history feature of Nakanishi, which is very limited. Furthermore, it would not have been obvious how the teachings of these two references could be combined, given that the call history feature of Nakanishi would have to be completely modified and reworked in order to be functional in the system of Bayless, requiring extensive experimentation and testing. And, as discussed above, one would not have been motivated to impose of the flexible system of Bayless the narrow and very limited function of Nakanishi.

At least for these reasons, one of ordinary skill in the art would not have been motivated to combine Bayless and Nakanishi as the Examiner suggests, and even if they were so combined,

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/392,619  
Attorney Docket No. Q55694

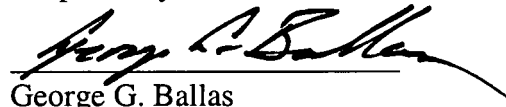
the combination still would not teach all of the features of applicants invention as claimed in independent claims 1, 5, 10, and 23.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

Respectfully submitted,

  
George G. Ballas  
Registration No. P-52,587

Date: February 4, 2003